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MAILED

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| In re Patent No. 7,171,354 | : | OFFICE OF PETITIONS |
| Issue Date: 30 January, 2007 | : | |
| Application No. 10/018,317 | : | ON PETITION |
| Filed: 18 December, 2001 | : | |
| Attorney Docket No. 009289-01226 | : | |

This is a decision on the petition filed 13 January, 2010, to waive the rules pursuant to 37 C.F.R. §1.183 and accept the correction of the assignee on the front page of the above-identified patent pursuant to 37 C.F.R. §1.323 and §3.81(a).

The requirements of the instant matter are set forth in in the Commentary at MPEP §307—Petitioner must provide not only the statement and showings, but also the proper fees, which requirement Petitioner has not fully satisfied with payment and/or authorization of charge.

The petition is **GRANTED**.

Petitioner requests issuance of a certificate of correction adding the name of “NEC Corporation.”

Petitioner’s original request of 31 August, 2009, was dismissed on 22 December, 2009, because Petitioner did not provide a copy of the assignment documents in question and the Office Abstract of the assignment at Reel/Frame 012554/0828 (12 February, 2002) indicated but a single Assignee in the name of Matsushita Electric Industrial Co., Ltd.

Petitioner’s submission of a copy of the underlying document—Assignment—evidences a second Assignee identified therein as **NEC Corporation**.

The regulations at 37 C.F.R. §3.81(a) permits the patent to issue to the assignee, provided that, at the time the issue fee is paid, the name of an assignee is provided. The regulations at 37 C.F.R. §3.81 (b) permits the patent to issue in the name of an assignee if the assignment was submitted after payment of the issue fee but prior to issuance of a patent. (See: the regulations The regulations at 37 C.F.R. §3.81(b)¹ and the guidance in the Commentary at MPEP §307.²)

¹ The regulations at 37 C.F.R. §3.81(b), effective June 25, 2004, provide:

After payment of the issue fee: Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in §3.11 before issuance of the patent, and must include a request for a certificate of correction under §1.323 of this chapter (accompanied by the fee set forth in §1.20(a) and the processing fee set forth in §1.17(i) of this chapter.

² The guidance in the Commentary at MPEP §307 provides:

307 Issue to Assignee [R-3]

35 U.S.C. §152. Issue of patent to assignee.

Patents may be granted to the assignee of the inventor of record in the Patent and Trademark Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title.

****>**

37 C.F.R. §3.81. Issue of patent to assignee.

(a) *With payment of the issue fee:* An application may issue in the name of the assignee consistent with the application's assignment where a request for such issuance is submitted with payment of the issue fee, provided the assignment has been previously recorded in the Office. If the assignment has not been previously recorded, the request must state that the document has been filed for recordation as set forth in §3.11.

(b) *After payment of the issue fee:* Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in § 3.11 before issuance of the patent, and must include a request for a certificate of correction under §1.323 of this chapter (accompanied by the fee set forth in § 1.20(a)) and the processing fee set forth in §1.17 (i) of this chapter.

(c) *Partial assignees.* (1) If one or more assignee, together with one or more inventor, holds the entire right, title, and interest in the application, the patent may issue in the names of the assignee and the inventor.

(2) If multiple assignees hold the entire right, title, and interest to the exclusion of all the inventors, the patent may issue in the names of the multiple assignees.<

Normally, for a patent to issue to an assignee, a request for issuance of the application in the name* of the assignee* must be filed in the United States Patent and Trademark Office (Office) at a date not later than the day on which the issue fee is paid.

****>**Such a request must indicate that the assignment has been previously recorded in the Office. If the assignment has not been previously recorded in the Office, the request must state that the document has been filed for recordation as set forth in 37 C.F.R. §3.11. See 37 C.F.R. §3.81(a).

If a request for issuance to an assignee pursuant to 37 C.F.R. §3.81(b) is submitted after the day on which the issue fee is paid, the request under 37 C.F.R. §3.81(b) must include a request for a certificate of correction under 37 C.F.R. §1.323 (accompanied by the fee set forth in 37 C.F.R. §1.20(a)) and the processing fee set forth in 37 C.F.R. §1.17(i). The request under 37 C.F.R. §3.81(b) must state that the assignment was submitted for recordation as set forth in 37 C.F.R. §3.11 before issuance of the patent. The Office will issue a certificate of correction to reflect that the patent issued to the assignee provided the requirements of 37 C.F.R. §3.81(b) and 37 C.F.R. §1.323 are complied with.<

Only the first appearing name of an assignee will be printed on the patent where multiple names for the same party are identified on the ****>**Fee(s)< Transmittal form, PTOL-85B. Such multiple names may occur when both a legal name and an "also known as" or "doing business as" name is also included. This printing practice will not, however, affect the existing practice of recording assignments with the Office in the Assignment Division. The assignee entry on form PTOL-85B should still be completed to indicate the assignment data as recorded in the Office. For example, the assignment filed in the Office and, therefore, the PTOL-85B assignee entry might read "Smith Company doing business as (d.b.a.) Jones Company." The assignee entry on the printed patent will read "Smith Company."

Irrespective of whether the assignee participates in the prosecution of the application, the patent issues to the assignee if so indicated on the ****>**Fee(s)< Transmittal form PTOL-85B. Unless an assignee's name and address are identified Transmittal form PTOL-the applicant. Assignment will be based solely on >Assignment information updated after a patent is reflective of the assignment subsequent to the issuance assignment information an assignment search on and by inspecting the documents.<

As noted above, Patent and Trademark Office assignment records disclose that an assignment to Matsushita Electric Industrial Co., Ltd. and **NEC Corporation** was recorded at Reel/Frame 012554/0828 on 12 February, 2002. Thereafter the patent issued as indicated above on 30 January, 2007. (*See*, generally in this regard: MPEP §307.)

Petitioner requests that a certificate of correction be issued to reflect the correct assignee on the front page of the Letters Patent in the patent to be issued from the application. The request was accompanied by a certificate of correction (and fee) as required by 3.81(b). Further, Office assignment records reflect assignment as set forth above.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.³

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Accordingly, because the request complies with the provisions of 37 C.F.R. 3.81(b), it is appropriate for a certificate of correction to be processed.

This matter is being referred to the Certificates of Correction Branch for processing of a certificate of correction.

A request for a certificate 37 C.F.R. §1.323 (see MPEP from incomplete or erroneous furnished >, or a missing PTOL-85B will not be under 37 C.F.R. §3.81(b) assignment was submitted in 37 C.F.R. 3.11 before request under 37 C.F.R. the Office of Petitions

- (A)the *>processing< 1.17(*>i<);
- (B)a request **>for the name of the assignee, corrected to state the name
- (C)a statement that submitted for recordation 3.11before the issuance of the
- (D)a **>request under 37 C.F.R. §1.323 accompanied in 37 C.F.R. §1.20(a).<

³ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

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Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁴) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

Any questions concerning the issuance of a certificate of correction should be directed to the Certificates of Correction Branch at (571) 272-4200.

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁴ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.